

**Amendments to the Drawings:**

The attached sheet of drawings includes changes to Fig. 1 and Fig. 4. This sheet, which includes Figs. 1 and 4, replaces the original sheet including Figs. 1 and 4.

In Fig. 1, previously omitted elements 32, 34, and 48 have been added to show the relationship between Figs. 1 and 2. In Fig. 4, elements 232, 236, and 242 are added to point to structure previously shown and described in the specification.

No new matter has been added.

Attachment: Replacement Sheet

Annotated Sheet Showing Changes

**REMARKS/ARGUMENTS**

**I. Applicants' Request Reconsideration of Examiner's Decision Regarding the Restriction/Election Requirement**

Claims 1-18 are pending. Applicants traversed the restriction requirement in the paper filed March 30, 2005 and provisionally elected to prosecute claims 1-16 and Figures 1-2. Claims 7-18 have been withdrawn from further consideration. Applicants request reconsideration of withdrawing claims 7-18 for the following reasons.

Claims 7-16 adds further limitations to claim 1. Claims 17-18 are method claims directed at the use of the apparatus of claim 1. All groups of claims are properly presented in the same application, and undue diverse searching should not be required since all the claims are in the same class. Should any of the generic claims be found allowed, it is noted that the Applicants are entitled to a reasonable number of species.

For the foregoing reasons, it is respectfully submitted that the requirement should be withdrawn and all the claims should be examined together to expedite the patent processes in accordance with U.S. Patent and Trademark Office Business Goals.

**II. Amendments to Drawings and Specification**

Figures 1 and 4 are amended. Figure 1 is amended to add reference numbers 32, 34, and 48 to illustrate the relationship between Figure 1 and Figure 2. Figure 4 is amended to add the reference numerals 232, 236 and 242 to represent structure previously shown and described in the specification. No new matter is added.

The specification is amended to correct informalities and clarify the description of Fig. 4. As previously shown in paragraph [0020] the reciprocation assembly is similar in many respects to the reciprocation assembly 30 described in the specification, and therefore "like reference numerals preceded by the number 1." Hence, like numbers

preceded by the number 2 are used to indicate like elements shown in assembly 30 and assembly 130. No new matter has been added.

### **III. Amendments to Claims and Remarks**

Claim 1 has been amended to correct the semicolon after "including".

Withdrawal of the claim objections is requested.

Claims 1-6 are rejected as being unpatentable over Pearl (US 3,815,221) in view of Henninger (US 3,274,409) and further in view of Balamuth (3,086,288). The Examiner stated Pearl discloses all the claimed elements except for the means for actuating the blade or a resonator assembly. The Examiner further states that Henninger discloses a resonator assembly and Balamuth discloses advantages for using a vibrating blade in cutting operations, particularly for cutting fabrics and leather.

Applicants' traverse the rejection and contend a prima facie case of obvious has not been made. The Examiner has the burden of going forward to show that the Applicants' claimed invention is obvious. See, In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). Also,

"In rejecting claims under 35 U.S.C. §103, the examiner bears the initial burden of presenting a prima facie case of obviousness.... If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." In re Rijckaert, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993).

As discussed in more detail below, the Examiner failed to carry the burden of presenting a prima facie case of obviousness for the claims. All of the cited references are inapposite to the claimed invention and are not pertinent to the problem addressed by the Applicants. Thus, the claimed invention cannot be said to have been obvious in view of those references. In addition, there is no basis for combining the teachings of

these references in the manner described by the Examiner. And even if the references could be combined, which the Applicants believe is improper, the result still would not yield the Applicants' claimed invention.

Pearl is not pertinent to the claimed invention. That reference discloses a method for holding sheet material by a vacuum hold down. Pearl does not disclose means for actuating the blade or a resonator assembly. Since Pearl does not disclose either means for actuating the blade or a resonator assembly, one of ordinary skill in the art trying to solve the problem addressed by the Applicants' invention involving means for actuating the blade or a resonator assembly would not even consider looking to Pearl.

The Examiner's attempt to fill in the inadequacies of Pearl with Henninger fails to establish a prima facie case of obviousness. Henninger discloses a reed driving machine. There is no disclosure or suggestion in Henninger to apply this apparatus to cutting sheet type work material as the Applicants' claim. In fact, Henniger teaches away from such a structure by having no cutting apparatus. Therefore, one of ordinary skill in the art attempting to solve the problem solved by the Applicants' invention would not consider the teachings of a reference that is not directed to cutting.

Henninger has absolutely no relevance to the problem addressed by the claimed invention. The Examiner's dismisses the purpose of the claimed invention and the disclosure of the cited references is contrary to controlling Federal Circuit authority.

[T]he purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve...If [the reference] is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it." In re Clay, 23 U.S.P.Q.2d 1058, 1061 (Fed. Cir. 1992).

Thus, there is no basis for combining the teachings of Pearl and Henninger as done by the Examiner in an attempt to yield the Applicants' claimed invention. Indeed, the Examiner made no showing as to why one of ordinary skill in the art seeking to provide a cutting machine to accurately control the blade when operating at high reciprocating rates would look to Pearl and Henninger to attempt to solve that problem.

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teachings or suggestion supporting the combination... The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification... Here, ***the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'***" In re Fritch, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992). See also In re Oetiker, *supra*, 24 U.S.P.Q.2d at 1446; In re Gordon, et. al., 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). (emphasis added).

Moreover, the combination of Pearl and Henninger with Balamuth is inappropriate because Balamuth discloses an ultrasonically vibrated cutting knife. Using the magnetic power disclosed in Henninger would result in an apparatus that would not function according to the disclosure in Balamuth that requires sound waves to function properly. It is well settled that references must be taken in their entireties, including those portions which argue against obviousness. See, Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 U.S.P.Q. 416, 420 (Fed. Cir. 1986). By combining Henninger that requires magnetism and Balamuth that requires sound waves, the proposed apparatus according to the disclosures of Henninger and Balamuth is inoperable or unable to function for its intended purpose. Such an inoperative product

cannot be the basis for a holding of obviousness. In re Sponnoble, 160 U.S.P.Q. 237, 244 (CCPA 1969).


If any issues remain, or if the Examiner has any suggestions for expediting allowance of the application, the Examiner is invited to contact the undersigned attorney.

**AUTHORIZATION**

The Assistant Commissioner is hereby authorized to charge any additional fees that may be required for this response to Deposit Account **13-4500**, Order No. **4757-4142US1**, and is hereby petitioned for any extension of time that may be required to make this response timely. **A DUPLICATE OF THIS SHEET IS ATTACHED.**

Respectfully submitted,  
**MORGAN & FINNEGAN, L.L.P.**

Date: September 15, 2005

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# ANNOTATED SHEET SHOWING CHANGES

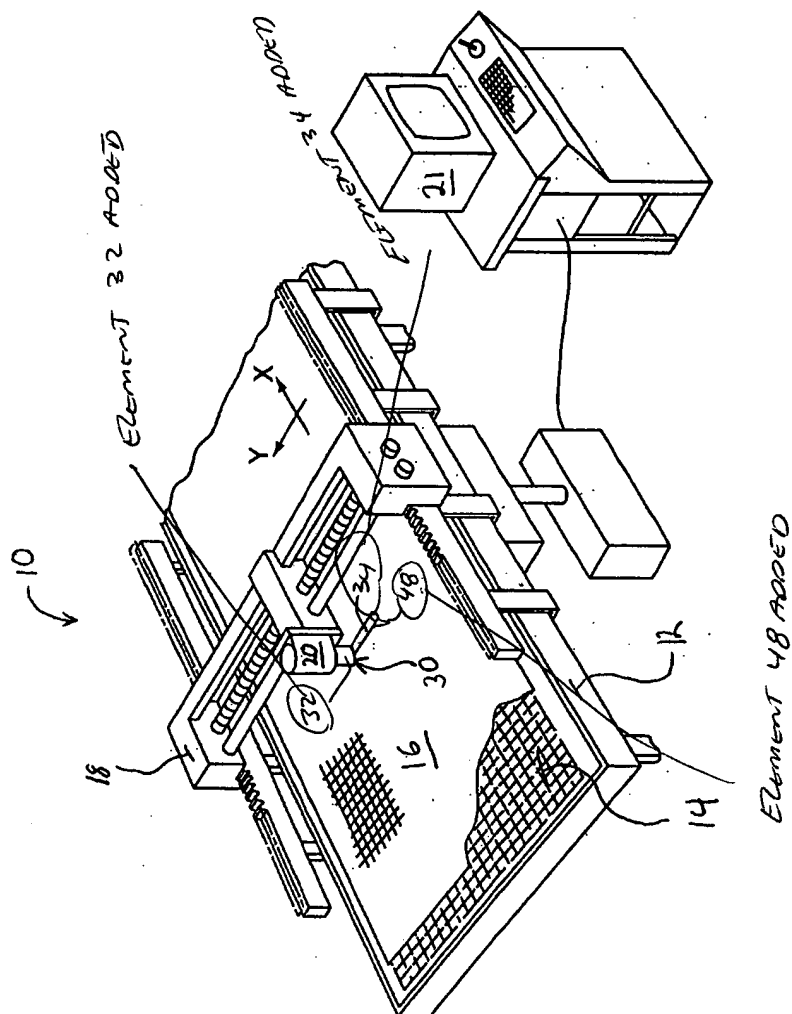


Fig. 1

↙ 230

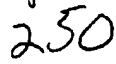


Fig. 4